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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicant:** Peter Blurton et al.

**Serial No.:** 10/534,584    **Case No.:** T1607P

Art Unit  
1625

**Filed:** May 11, 2005

**Auth. Off.:**  
Z. Davis

**For:** AMINO-HETEROCYCLES AS VR-1 ANTAGONISTS FOR  
TREATING PAIN

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

This paper is filed in response to the restriction requirement mailed March 7, 2008 and for which a response is due on April 7, 2008. Claims 1-9 and 11 are currently pending in the application and are subject to the following restriction under 35 U.S.C. 121:

Group I: Claims 1-9, drawn to a chemical compound and a pharmaceutical composition of formula (I).

Group II: Claim 11, drawn to a method for the treatment of a disease or condition in which pain predominates using a chemical compound of formula (I).

Group III: Claim 11, drawn to a method for the prevention of a disease or condition in which pain predominates using a chemical compound of formula (I).

Group IV: Claim 11, drawn to a method for the treatment of a disease or condition in which inflammation predominates using a chemical compound of formula (I).

Group V: Claim 11, drawn to a method for the prevention of a disease or condition in which inflammation predominates using a chemical compound of formula (I).

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Applicants elect Group I, claims 1-9, drawn to a chemical compound and a pharmaceutical composition of formula (I) with traverse.

35 U.S.C. 121 specifies that if two or more independent and/or distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. See MPEP 802.01. Independent generally means that there is no disclosed relationship between the two or more claimed inventions. "Distinct" means that the inventions, although related, are capable of separate use and patentably distinguishable.

The Examiner based the restriction on the ground that the present inventions have no single general inventive concept. On the contrary, the present invention is closely related in that the compounds are VR-1 antagonist used to treat pain and/or inflammation. Thus, a search of the compounds in relation to their use would require no additional burden on the part of the Examiner to conduct the prior art search for examination of the present application in total. Regarding the method of use and composition claims, the Examiner can access information regarding these claims while searching for the compound themselves. Thus, there is minimal burden on the Examiner to examine Groups I-VI.

Applicants further request that the Examiner apply procedures for the rejoinder of withdrawn method claims consistent with MPEP 821.04 (e.g. the Official Gazette Notice (1184 O.G. 86) of March 26, 1996, and the "Training Materials for Treatment of Product and Process Claims in Light of *In re Brouwer* and *In re Ochiai* and 35 U.S.C. 103 (b)"). Applicants note that the method claims already include all the limitations of the main product claim.

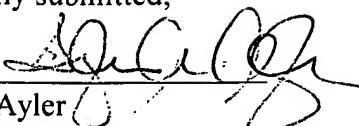
As required by the Examiner, applicants further elect the compound of claim 59 as the species, and assert that claims 1-11 are identified as encompassing the elected invention.

In view of the above, the Examiner is respectfully requested to withdraw the restriction requirement.

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Authorization is hereby given to charge any fees which may be due as a result of this petition to Deposit Account No. 13-2755.

Respectfully submitted,

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